

Attorney Docket No.: P-US-TN-3305
Application Serial No.: 10/688,668REMARKS

The Office Action dated January 5, 2011, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claim 85 has been amended and claim 86 has been added. No new matter is presented. Support for new claim 86 and the amendments to claims 85 can be found in at least paragraph [0052] of the application as originally filed. Claims 1, 3, 5, 66-69, 71, 80, 81 and 83-86 are pending and respectfully submitted for consideration.

Rejections Under 35 U.S.C. § 103Claims 1-3, 5 and 85

Claims 1-3, 5 and 85 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. (U.S. Patent No. 6,347,624, "Smith") in view of Tsao (U.S. Patent No. 6,263,866) and further in view of Greenland (U.S. Patent No. 6,276,990, "Greenland"). As noted in the previous Response filed October 15, 2010, claim 2 has been canceled. Claims 3, 5 and 85 depend from claim 1.

Smith was cited for disclosing many of the claimed elements of the invention with the exception of a first rail being adjustable in a direction lateral to the longitudinal axis, a motor assembly pivotable supported by a support assembly, and a switch disposed proximate to the motor assembly. Tsao and Greenland were cited for curing these deficiencies. The Applicant traverses the rejection and respectfully submits that claims 1, 3, 5 and 85 recite subject matter that is neither disclosed nor suggested by the cited references.

Claim 1, recites, in part, "a saw assembly disposed on at least one of the base and the frame assembly, the saw assembly comprising a support assembly, a motor assembly pivotably supported by the support assembly, the support assembly remaining stationary relative to pivotal movement of the motor assembly and the motor assembly being pivotable about a pivot axis substantially parallel to the longitudinal axis, and a cutting wheel driven by the motor assembly, the cutting wheel having a plane substantially parallel to the pivot axis." The Office Action asserted that Smith discloses "a saw assembly (500)...a support assembly (400), a motor assembly (500) and a cutting wheel (fig. 1) driven by the motor assembly..." See the paragraph bridging pages 2 and 3 of the Office Action. The Office Action acknowledged that Smith does

Attorney Docket No.: P-US-TN-3305
Application Serial No.: 10/688,668

not disclose the claimed motor assembly pivotably supported by the support assembly." See page 3, paragraph 2 of the Office Action. Greenland, in particular, was cited for curing this deficiency. Specifically, Greenland was cited for teaching a saw assembly "positioned on a U-shaped frame, such that the saw and the motor assembly are pivotable in order to position the blade to make bevel cuts in the workpiece..." The Office Action stated that "[i]t would have been obvious to one having ordinary skill in the art at the time of the invention to have substituted or modified the cutting assembly of [Smith] for the cutting assembly of Greenland to allow for movement of the saw blade relative to the support assembly..." See the paragraph bridging pages 4 and 5 of the Office Action.

The Applicant notes that the rationale provided in the Office Action for modifying Smith only included "movement of the saw blade relative to the support assembly." There is no rationale provided for modifying Smith to have "a motor assembly pivotably supported by the support assembly."

As stated in MPEP § 2141:

the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S. Ct. 1727 (2007)] noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

The Applicant respectfully submits that the Office Action did not provide a rationale to combine Smith, Tsao and Greenland to teach a motor assembly pivotably supported by the support assembly, the support assembly remaining stationary relative to pivotal movement of the motor assembly and the motor assembly being pivotable about a pivot axis substantially parallel to the longitudinal axis, and a cutting wheel driven by the motor assembly, the cutting wheel having a plane substantially parallel to the pivot axis, as recited in claim 1.

As such, the Office Action has not set forth a *prima facie* case of obviousness of claim 1. In view of the above, the Applicant respectfully submits that claim 1 is allowable and requests withdrawal of the rejection of claims 1, 3, 5, and 85.

Attorney Docket No.: P-US-TN-3305
Application Serial No.: 10/688,668

Claim 71

Claim 71 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Tsao and further in view of Greenland and Sigitich et al. (U.S. Patent No. 4,428,159).

The Applicant traverses the rejections and respectfully submits that claim 71 recites subject matter that is neither disclosed nor suggested by the cited references. Claim 71 depends from claim 1, which is allowable for the reasons submitted above.

Claim 80

Claim 80 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Tsao and further in view of Greenland and further in view of Lee (U.S. Patent No. 5,676,124), Jameson (U.S. Patent No. 3,777,792), Weissman (U.S. Patent No. 4,885,956), Mayfield (U.S. Patent No. 5,063,806), Rueb (U.S. Patent No. 5,577,428), Welch (U.S. Patent No. 5,906,528) and Gorgol et al. (U.S. Patent No. 6,273,081).

The Applicant traverses the rejections and respectfully submits that claim 80 recites subject matter that is neither disclosed nor suggested by the cited references. Claim 80 depends from claim 1, which is allowable for the reasons submitted above.

Claims 67-68, 83 and 84

Claims 67-68, 83 and 84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Tsao and Greenland and further in view of Lee, Jameson, Weissman, Mayfield, Rueb, Welch, and Gorgol.

As a preliminary matter, it appears that the Office Action rejection includes claim 66 as indicated in the Office Action Summary. Clarification is requested.

Smith was cited for disclosing many of the claimed elements of the invention with the exception of a first rail being adjustable in a direction lateral to the longitudinal axis, a motor assembly pivotable supported by a support assembly, a switch disposed proximate to the motor assembly. Tsao, Greenland, Lee, Jameson, Weissman, Mayfield, Rueb, Welch, and Gorgol were cited for curing these deficiencies. Claims 68 and 84 depend from claim 67 and claim 83 depends from claim 66. The Applicant traverses the rejection and respectfully submits that

Attorney Docket No.: P-US-TN-3305
Application Serial No.: 10/688,668

claims 66-68, 83, and 84 recite subject matter that is neither disclosed nor suggested by the cited references.

Claims 66 and 67, recite, in part, "a saw assembly disposed on at least one of the base and the frame assembly, the saw assembly comprising a support assembly, a motor assembly pivotably supported by the support assembly, the motor assembly being pivotable about a bevel axis substantially parallel to the longitudinal axis, and a cutting wheel driven by the motor assembly, the cutting wheel having a plane substantially parallel to the bevel axis." As discussed above, the Office Action has not provided a rationale for combining Smith with Tsao and Greenland to teach a motor assembly pivotably supported by the support assembly, the support assembly remaining stationary relative to pivotal movement of the motor assembly and the motor assembly being pivotable about a pivot axis substantially parallel to the longitudinal axis. The Office Action merely cited the Greenland patent which shows a pivotable motor, but without a rationale for combining Smith and Tsao with Greenland to teach a motor assembly pivotably supported by the support assembly.

Further, none of Lee, Jameson, Weissman, Mayfield, Rueb Welch, or Gorgol cures the deficiencies in Tsao and Greenland. As such, the Office Action has not set forth a *prima facie* case of obviousness of claims 66 and 67, and therefore, dependent claims 68, 83 and 84.

Accordingly, the Applicant respectfully submits that claims 66 and 67 and dependent claims 68, 81, 83, and 84 are allowable.

Claim 69

With respect to claim 69, the Applicant respectfully requests clarification on the references cited. Claim 69 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Tsao and Greenland and further in view of Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Gorgol and further in view of McCambridge et al. (U.S. Patent No. 4,350,193), Marcoux et al. (U.S. Patent No. 3,342,226), Brenta (U.S. Patent No. 4,105,055), Sanfilippo (U.S. Patent No. 6,745,803) and Otto (U.S. Patent No. 5,161,590).

The Applicant traverses the rejections and respectfully submits that claim 69 recites subject matter that is neither disclosed nor suggested by the cited references. Claim 69 depends from claim 67, which is allowable for the reasons submitted above.

Attorney Docket No.: P-US-TN-3305
Application Serial No.: 10/688,668

Claim 81

Claim 81 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsao in view of Greenland, Lee '961, Jameson, Weissman, Mayfield, Rueb, Welch, and Gorgol and further in view of Sigitich.

The Applicant traverses the rejections and respectfully submits that claim 81 recites subject matter that is neither disclosed nor suggested by the cited references. Claim 81 depends from claim 66, which is allowable for the reasons submitted above.

Conclusion

The Applicant does not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, the Applicant has not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application. Moreover, there may be alternative or additional reasons for patentability not discussed in this response.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's deposit account No. 02-2548, referencing Attorney Dkt. No. P-US-TN-3305.

Respectfully submitted,

Date: May 5, 2011

Rhonda Barton
Rhonda Barton
Attorney for Applicant
Reg. No. 47,271

The Black & Decker Corporation
701 East Joppa Road, TW199
Towson, MD 21286
Telephone No.: (410) 716-2886
Facsimile No.: (410) 716-2610

Enclosure: Petition for Extension of Time (one month)